



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/544,517 04/06/00 LUCHE R 200125.410

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EXAMINER

PATTERSON, C

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

08/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/544,517	Applicant(s) LUCHE ET AL.	
	Examiner Charles L. Patterson, Jr.	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: |

Art Unit: 1652

Restriction to one of the following inventions is required under 35

U.S.C. 121:

- I. Claims 1, 26-29 and 47-49, drawn to a DSP-4 polypeptide, a method for screening for an agent that modulates DSP-4 activity and a method of screening a molecule for the ability to interact with DSP-4, classified in class 435, subclass 21 and 196.
- II. Claims 2-14 and 22-25, drawn to a polynucleotide, a vector containing the polynucleotide, a host cell containing the vector, an antisense polynucleotide, a method of producing DSP-4 by using the host cell and a method of detecting DSP-4 expression, classified in class 435, subclasses 196, 320.1, 252.3 and class 536, subclass 23.2 and 24.3.
- III. Claims 15-21, drawn to an antibody, a pharmaceutical composition comprising the antibody, a method of use of the antibody, classified in class 435, subclass 7.4 and class 530, subclass 387.9.
- IV. Claims 30-32 and 42, drawn to a method for screening for a agent that modulates DSP-4 activity, classified in class 435, subclass 6.
- V. Claims 33 and 36-39, drawn to a method for modulating a proliferative response in a cell, classified in classes 424 and 514, numerous subclasses.
- VI. Claims 34 and 36-39, drawn to a method for modulating differentiation of a cell, classified in classes 424 and 514, numerous subclasses.
- VII. Claims 35-41, drawn to a method for modulating survival of a cell, classified in classes 424 and 514, numerous subclasses.

Art Unit: 1652

VIII. Claims 43-44, drawn to a method for treating a patient afflicted with a disorder associated with DSP-4 activity, classified in class 424 and 514, numerous subclasses.

IX. Claims 45-46, drawn to a DSP-4 substrate trapping mutant polypeptide, classified in class 530, subclass 350.

Note that Groups V-VII contain claims 36-39.

The inventions are distinct, each from the other because:

Groups I-III and IX are drawn to completely different chemical compounds that patentably distinct.

The method of Group IV involves a DSP-4 promoter and is unrelated to any of the other groups.

Groups V-VII involve contacting a cell with an unspecified agent that modulates DSP-4 activity and are unrelated to any of the other groups. Group VIII involves administering to a patient an unspecified agent that modulates DSP-4 activity and is unrelated to any other of the groups.

Group IX is drawn to a DSP-4 substrate trapping mutant protein that has a reduced activity, including no activity. The instant protein is chemically different from the polypeptide of Group I and is patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Application/Control Number: 09/544,517

Art Unit: 1652

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 703-308-1834. The examiner can normally be reached on Monday - Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7401 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
August 21, 2001